



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,866	07/15/2003	Mariana Benitez Pelaez	42430-10650	7771

47377 7590 10/07/2005

JENNER & BLOCK LLP  
ONE IBM PLAZA  
CHICAGO, IL 60611

EXAMINER
----------

TIEU, BENNY QUOC

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/619,866

Applicant(s)

PELAEZ ET AL.

Examiner

Benny Q. Tieu

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 6-12 have been renumbered 5-11.

2. Claims 9-11 are objected to because of the following informalities: “a user device” is repeated used in the claims. It is not clear whether or not a user device is the same or different device. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2642

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Dahlen (U.S. Patent No. 5,870,454).

Regarding claim 1, Dahlen teaches a method for providing a text message to a user in a communications system, the method comprising the steps of:

establishing communications with the communications system from a user device (column 3, lines 48-50);

selectively coupling to a speech-to-text server that converts speech to text (Fig. 1, 80);

the speech-to-text server converting speech from the user device to a text message (column 7, lines 10-12); and

the speech-to-text server storing the text message (column 7, lines 32-34).

Regarding claim 2, Dahlen teaches the method further comprising the step of sending the text message to a user device (column 8, lines 30-33).

Regarding claims 3 and 4, see Fig. 2A.

5. Claims 5-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al. (U.S. Patent Application Publication No. 2004/0252679).

Regarding claim 5, Williams et al. teach a telecommunications network that provides speech-to-text processing, the telecommunications network comprising:

a network access device (Fig. 13, 1304) coupled to the telecommunications network (Fig. 13, 1300);

a voicemail system coupled to the telecommunications network to store audio messages (Fig. 13, 1305); and

an application processor coupled to the voicemail system to receive voicemail messages and convert the voicemail messages to text (Fig. 14, 1403).

Regarding claim 6, Williams et al. further teach the network wherein the text is sent to a destination over a packet-based network (Fig. 14, 1403).

Regarding claim 7, Williams et al. further teach the network wherein the text is sent as one of a facsimile transmission, an email, and a Web page posting (Fig. 1).

Regarding claim 8, Williams et al. teach a method for receiving text messages in a telecommunications network, the method comprising the steps of:

receiving an incoming call (Fig. 14, 1401);

determining whether to receive voice or a text message in response to the incoming (it is inherent that the system would know what kind of incoming call is);

receiving a voice message from a user device coupled to the telecommunications network (Fig. 12, 1201);

converting the voice message to a text message corresponding to the voice message (Fig. 14, 1403); and

sending the text message to a user device (Fig. 14, 1403).

Regarding claims 9-11, see Fig. 15.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Penzias (U.S. Patent No. 5,475,738) teaches an interface between text and voice messaging systems. Hyde-Thomson (U.S. Patent No. 5,557,659) teaches an electronic mail

Art Unit: 2642

system having integrated voice messages. Irribarren (U.S. Patent No. 5,737,395) teaches a system and method for integrating voice, facsimile and electronic mail data through a personal computer. Picard et al. (U.S. Patent No. 6,233,318) teach a system for accessing multimedia mailboxes and messages over the internet and via telephone. Owens et al. (U.S. Patent No. 6,633,630) teach a system for integrated electronic communications.

7. Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7490, (for informal or draft communications, please label

“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to:

Customer Service Window

Randolph Building

401 Dulany Street

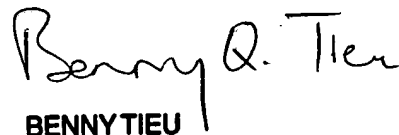
Alexandria, VA 22314

Art Unit: 2642

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benny Q. Tieu whose telephone number is (571) 272-7490. The examiner can normally be reached on Monday-Friday: 6:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**BENNY TIEU**  
**PRIMARY EXAMINER**

Art Unit 2642  
September 30, 2005